

## **REMARKS/ARGUMENTS**

### ***Examiner's Objections***

The Examiner objected to the specifications for the reason that paragraph [0054] should reference Figure 10 in lieu of Figure 11. The specification has been amended to reference Figure 10 in paragraph [0054].

### ***Amendments in General/ Claim Rejections – 35 U.S.C. § 112***

1. Claim 25 was a duplicate of claim 5. Accordingly, claim 25 has been cancelled. Claim 3 incorrectly depended on cancelled claim 2 instead of claim 1. Claim 3 now correctly depends on claim 1.
2. Claim 1 has been amended to include the limitations of claims 11, 12 and 13. Claims 11, 12, and 13 have been cancelled. Claims 14 and 15 depended on cancelled claim 12. Claims 14 and 15 now depend on claim 1.

### **Standards for Patentability**

3. "An applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. It is the Commissioner's duty (acting through the examining officials) to determine that all requirements of the Patent Act are met. The burden is on the Commissioner to establish that the applicant is not entitled under the law to a patent . . . . In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct." *In re Oetiker*, 977 F.2d 1443, 1449, 24 USPQ2d 1443, 1447, 24 USPQ2d at 1447 (Fed. Cir. 1992) (Plager, J., concurring).
4. "The precise language of 35 USC 102 that 'a person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103." *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968).

***Claim Rejections - 35 USC § 103***

**Claims 1, 11, 16, 18-22, 26, and 28**

5. The Examiner rejected claims 1, 11, 16, 18-22, 26, and 28 under 35 U.S.C. § 103 (a) as being unpatentable (obvious) over Dominguez (6,560,473) in view of Sudjak (6,847,836). The Examiner contends the basic structural features of Applicant's invention are disclosed by Dominguez with electrodes extension suggested by Sudjak. Claim 11 has been cancelled. Claim 1 has been amended to include the limitations of claims 11, 12, and 13, i.e., to include the limitations of having a pad body with an adhesive cover and embedded electrodes with an extension device where the electrodes extend beyond the adhesive surface when the adhesive cover is removed. Claims 16, 18-22, 26, and 28, which depend on claim 1, presently include these limitations.

6. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 706.02(j).

7. Neither Dominguez nor Sudjak make any mention of extending electrodes that extend when an adhesive cover is removed. Therefore, Dominguez and Sudjak, when combined, do not teach or suggest all the claim limitations of claims 16, 18-22, 26, and 28.

8. For the foregoing reasons, Applicant respectfully contends that claims 1, 16, 18-22, 26, and 28 are not obvious over Dominguez in view of Sudjak.

**Claims 3, 5, 6, 8-10, and 25**

9. Claims 3, 5, 6, 8-10, and 25 were rejected by the Examiner as being unpatentable over Dominguez in view of Sudjak and further in view of Rogel (6,259,939). Claim 25 has been cancelled. Claim 1 has been amended to include the limitations of claims 11, 12 and 13 i.e. to

include the limitations of having a pad body with an adhesive cover, and embedded electrodes with an extension device wherein the electrodes extend beyond the adhesive surface when the adhesive cover is removed. Claims 3, 5, 6, and 8-10, which depend on claim 1, presently include these limitations.

10. Neither Dominguez, Sudjak, or Rogel teach extending electrodes that extend when an adhesive cover is removed. Therefore, Dominguez, Sudjak and Rogel, do not teach or suggest all the claim limitations of claims 3, 5, 6, and 8-10.

11. For the foregoing reasons, Applicant respectfully contends that claims 3, 5, 6, and 8-10 are not obvious over Dominguez, Sudjak, and Rogel.

#### **Claims 4 and 17**

12. Claims 4 and 17 were rejected by the Examiner as being unpatentable over Dominguez in view of Sudjak and further in view of Haines et al (6,385,473). Claim 1 has been amended to include the limitations of claims 11, 12, and 13, i.e., to include the limitations of having a pad body with an adhesive cover and embedded electrodes with an extension device that allows the electrodes to extend beyond the adhesive surface when the adhesive cover is removed. Claims 4 and 17, which depend on claim 1, presently include these limitations.

13. Neither Dominguez, Sudjak, or Haines make any mention of extending electrodes that extend when an adhesive cover is removed. Therefore, Dominguez, Sudjak and Haines, when combined, do not teach or suggest all the claim limitations of claims 4 and 17.

14. For the foregoing reasons, Applicant respectfully contends that claims 4 and 17 are not obvious over Dominguez in view of Sudjak and Haines.

#### **Claims 7 and 23**

15. Claims 7 and 23 were rejected by the Examiner as being unpatentable over Dominguez in view of Sudjak and further in view of Mok et al (6,643,541). Claim 1 has been amended to include the limitations of claims 11, 12, and 13, i.e., to include the limitations of having a pad body with an adhesive cover and embedded electrodes with an extension device that allows the electrodes to extend beyond the adhesive surface when the adhesive cover is removed. Claims 7 and 23, which depend on claim 1, presently include these limitations.

16. Neither Dominguez, Sudjak, or Mok make any mention of extending electrodes that extend when an adhesive cover is removed. Therefore, Dominguez, Sudjak, and Mok when combined, do not teach or suggest all the claim limitations of claims 7 and 23.

17. For the foregoing reasons, Applicant respectfully contends that claims 7 and 23 are not obvious over Dominguez in view of Sudjak and Mok.

#### **Claims 12-14**

18. Claims 12-14 were rejected by the Examiner as being unpatentable over Dominguez in view of Sudjak and further in view of Sekine (5,224,479). Claims 12 and 13 have been cancelled. Claim 1 has been amended to include the limitations of claims 11, 12, and 13, i.e., to include the limitations of having a pad body with an adhesive cover, and embedded electrodes with an extension device that extend beyond the adhesive surface when the adhesive cover is removed. Claim 14, which depends on claim 1, presently includes these limitations.

19. Neither Dominguez, Sudjak, or Sekine make any mention of extending electrodes that extend when an adhesive cover is removed. Therefore, Dominguez, Sudjak, and Sekine when combined, do not teach or suggest all the claim limitations of claim 14.

20. For the foregoing reasons, Applicant respectfully contends that claim 14 is not obvious over Dominguez in view of Sudjak and Sekine.

#### **Claim 15**

21. Claim 15 was rejected by Examiner as being unpatentable over Dominguez in view of Sudjak and Sekine and further in view of Rollman et al (5,370,116). Claim 1 has been amended to include the limitations of claims 11, 12, and 13, i.e., to include the limitations of having a pad body with an adhesive cover and embedded electrodes with an extension device that allows the electrodes to extend beyond the adhesive surface when the adhesive cover is removed. Claim 15, which depends on claim 1, presently includes these limitations.

22. Neither Dominguez, Sudjak, Sekine, or Rollman make any mention of extending electrodes that extend when an adhesive cover is removed. Therefore, Dominguez, Sudjak, Sekine, and Rollman when combined, do not teach or suggest all the claim limitations of claim 15.

23. For the foregoing reasons, Applicant respectfully contends that claim 15 is not obvious over Dominguez in view of Sudjak, Sekine, and Rollman.

#### **Claim 24**

24. Claim 24 was rejected by the Examiner as being unpatentable over Dominguez in view of Sudjak, Rogel, Sekine, and Haines. Claim 1 has been amended to include the limitations of claims 11, 12, and 13, i.e., to include the limitations of having a pad body with an adhesive cover and embedded electrodes with an extension device that allows the electrodes to extend beyond the adhesive surface when the adhesive cover is removed. Claim 24, which depends on claim 1, presently includes these limitations.

25. Neither Dominguez, Sudjak, Rogel, Sekine, or Haines make any mention of extending electrodes that extend when an adhesive cover is removed. Therefore, Dominguez, Sudjak, Rogel, Sekine, and Haines when combined, do not teach or suggest all the claim limitations of claim 24.

26. For the foregoing reasons, Applicant respectfully contends that claim 24 is not obvious over Dominguez in view of Sudjak, Rogel, Sekine and Haines.

#### **Claim 27**

27. Claim 27 was rejected by Examiner as being unpatentable over Dominguez, Sudjak, Sekine, and Haines. Claim 1 has been amended to include the limitations of claims 11, 12, and 13, i.e., to include the limitations of having a pad body with an adhesive cover and embedded electrodes with an extension device that allows the electrodes to extend beyond the adhesive surface when the adhesive cover is removed. Claim 27, which depends on claim 1, presently includes these limitations.

28. Neither Dominguez, Sudjak, Sekine, or Haines make any mention of extending electrodes that extend when an adhesive cover is removed. Therefore, Dominguez, Sudjak, Sekine, and Haines when combined, do not teach or suggest all the claim limitations of claim 27.

29. For the foregoing reasons, Applicant respectfully contends that claim 27 is not obvious over Dominguez in view of Sudjak, Sekine, and Haines.

***Conclusion***

This response and the associated amendments add no new matter.

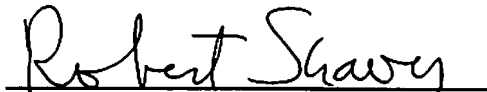
The above "Amendments to the Claims" section replaces the same section in the Applicant's May 14, 2007, Response to the Examiner's Action mailed December 12, 2006.

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 21<sup>st</sup> day of June, 2007.

Very respectfully,

A handwritten signature in cursive script, reading "Robert Shaver", written over a horizontal line.

Robert L. Shaver  
Reg. No. 42,145  
(208) 345-1122

**CERTIFICATE OF MAILING**

I HEREBY CERTIFY that this correspondence is being electronically deposited with the United States Patent Office via the EFS-Web on the below date as addressed to:

Mail Stop Amendment  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

DATE: June 21, 2007

A handwritten signature in black ink, appearing to read "Julie O'Tyson", written over a horizontal line.

Julie O'Tyson  
Intellectual Property Paralegal